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09/701,861	12/05/2000	Robert Kaplan		9101

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Robert Kaplan  
4 Creswick Walk  
London, NW11 6AN  
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EXAMINER
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PEREZ DAPLE, AARON C

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/701,861

**Applicant(s)**

KAPLAN, ROBERT

**Examiner**

Aaron C Perez-Daple

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Action is in response to Amendment filed 2/28/05, which has been fully considered.
2. Claims 1-31 have been cancelled by Applicant.
3. New claims 32-42 are presented for examination.
4. This Action is Final.

### ***Information Disclosure Statement***

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

6. The amendment filed 2/28/05 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: pg. 31, line 13 – pg. 32, line 5; pg. 33, line 1 – pg. 34, line 16 of amendment to the specification filed 2/28/05.

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Applicant is required to cancel the new matter in the reply to this Office Action.

Comments on the relevance of the prior art may be submitted separately with the IDS statement.

7. The specification is further objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitation of updating individual account data, as recited in lines 3-4 of claim 35, and lines 2-4 of claim 36, is not supported by the specification. No new matter should be entered.
8. In addition, it is not necessary to list headings which are “not applicable.” These headings may be removed from the specification.

#### ***Claim Objections***

9. **Claims 33-41** are objected to because of the following informalities: the claims recite “A system for transferring or requesting data via a communication network according to...” where they should recite -- A data carrier reader according to --. Appropriate correction is required.
10. Claim 33 is further objected to because the claim recites “said server location” in line 4, where it should recite -- said server address location--. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. **Claims 35-41** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the disclosure as originally filed does not appear to provide support for the limitations of *updating individual account data*, as recited in lines 3-4 of claim 35, and lines 2-4 of claim 36. If the disclosure does provide such support, Applicant is respectfully requested to point out the pages, line numbers, and figures where this support may be found. Note that the Examiner interprets broadly that “individual account data” may consist of data stored at an individual URL, for example, which interpretation is supported by the original disclosure. However, the disclosure does not appear to provide support for individual account data which would be linked to a specific user (e.g. individual *user* account data).

13. As dependent claims, claims 37-41 suffer from the same deficiencies as claims 35 and 36.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. **Claims 32-41** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, lines 10-11 of claim 32 recite, “further data after said communication link is established.” It is not clear what is being claimed with respect to this data, or what the relationship is between the data and the other recited elements of the claim

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(e.g. Is an action being performed on the data? Is the data being transferred/received to or from the server?). The Examiner interprets that the ability to transfer any additional data over the communication link meets this limitation of the claims.

16. As dependent claims, claims 33-41 suffer from the same deficiencies as claim 32.
17. **Claim 42** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the phrase “directly in the background” recited in line 3 is not clear to the Examiner (e.g. What is being performed in the background? In the background of what?). In addition the phrase “and or” in line 5 renders the claim indefinite, because it is not clear whether the Applicant intends to claim *and*, *or*, or *and/or*. The Examiner interprets that only one of the recited elements is necessary to meet the limitation of the claim (e.g. and/or).

### ***Claim Rejections - 35 USC § 102***

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. **Claims 32-34 and 42** are rejected under 35 U.S.C. 102(e) as being anticipated by Reber et al. (US 5,938,726) (hereinafter Reber).

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20. As for claim 32, Reber discloses a data carrier reader (data reader 30, Fig. 1) containing the means within itself to interpret data as read from a data carrier (Fig. 2), then activate if not already active a communication link program in an attached computing device (network access apparatus 22, Fig. 2) to enable the transferring of data indicative of server address location data to said communication link program thereby forming a communication link to said server address location (electronic address 26 and/or node 24, Fig. 1) and further data after said communication link is established (col. 5, lines 21-30; col. 6, lines 28-45).
21. As for claim 33, Reber discloses a system for transferring or requesting data via a communication network according to claim 32 in that said reader includes the means to coordinate the transfer of any additional data from a data carrier to a server address location after a communication link to said server location has been established (col. 5, lines 21-30).
22. As for claim 34, Reber discloses a system for transferring or requesting data via a communication network according to claim 33 in that said system includes the means for an Internet server location being arranged to open a specific account at said server location and transmit or not data following receipt of individual account reference data transmitted to said server location (col. 8, line 65 – col. 9, line 8).
23. As for claim 42, Reber discloses a system for transferring or requesting data via a communication network in that a data carrier relating to an individual account (as specified by a URL, for example) at a server location is accessed directly in the background by forming a connection utilizing individual account data, account server address data and or telephone reference data (col. 5, lines 21-30; col. 6, lines 28-45; col. 8, line 65 – col. 9, line 8).

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. **Claims 35-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber in view of Walker et al. (US 6,754,636 B1) (hereinafter Walker).

26. As for claims 35 and 36, Reber does not specifically disclose updating individual account data. Walker teaches updating individual account data stored in a server by monitoring the continued access to a remote location in order to provide payment for goods (col. 27, lines 32-57; Figs. 21 B & C). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reber by updating individual account data stored in a server by monitoring the continued access to a remote location in order to provide payment for goods, as taught by Walker above.

27. As for claim 37, Reber discloses a system for transferring or requesting data via a communication network according to claim 36 in that the location address and further data recorded on a data carrier predetermines the actions of the data carrier reader for activating a communication link program utilizing said address data read from said carrier data and the transferring of any additional data (col. 5, lines 21-30).

28. As for claim 38, Reber discloses a system for transferring or requesting data via a communication network according to claim 37 in that said reader further comprising the means of determining whether server location address data also includes direct



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communication link, wherein if said data also includes a direct communication link address data, said reading means being arranged to select then activate the correct communication path program in said computing device to enable the transfer of information to and from said server location via said communication link (col. 5, lines 21-30).

29. As for claim 39, Reber discloses a system for transferring or requesting data via a communication network according to claim 38 in that said computing device contains said reader that is inseparable or built within itself (data reader 174, Fig. 12; Fig. 14; col. 17, lines 17-18).
30. As for claim 40, Reber discloses a system for transferring or requesting data via a communication network according to claim 39 in that said reader interprets data carrier data that may be constituted by magnetic, electrical, optical, cable, CD ROM, embedded, radio signal, source or object code, barcode, integrated circuit, smart card or entity being adapted for performing, or for use in the performance of the relevant processes (Fig. 1; col. 4, line 35 – col. 5, line 4).
31. As for claim 41, Reber does not specifically disclose that the data carrier may utilize radio signals to form a wireless connection with the data reading means. It is well-known and expected in the art to use wireless communication devices for transmitting data. See, for example, US 6,747,692 B2. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reber by utilizing radio signals to form a wireless connection between the data carrier and the data reading means in order to transmit data without physical contact.

*Response to Arguments***102 Claim Rejections**

32. Applicant's arguments filed 2/28/05 have been fully considered but they are not persuasive. First the Examiner notes that the arguments have been made with respect to cancelled claims 19-31 and are therefore moot. However, to the extent that the new claims correspond with the old claims, the Examiner will address the primary arguments presented.

First, in item 15, Applicant asserts that Reber does not disclose the data carrier reader having the means to activate a program in a related or combined unit. The Examiner respectfully disagrees. The previously cited passage col. 5, lines 21-30 makes it clear that Reber performs in precisely this manner:

Generally, the machine-readable data 16 can include instructions which direct the network access apparatus 24 to execute any combination of: a predetermined client routine (e.g. a predetermined Internet browser routine), a predetermined network provider access routine (e.g. dialing and logging on to a predetermined service provider), and navigation instructions for automatically linking the network access apparatus 22 to the electronic address 26 via the electronic network 20.

Specifically, the Examiner interprets that the *network access apparatus 24* of Reber corresponds to the claimed *attached computing device*. The *client routine* of Reber corresponds to the claimed *communication program*. With respect to item 22, Applicant cites the same passage as evidence that Reber requires instruction data on the data carrier, stating that the presently claimed invention does not require such instruction data. However, this point is moot because the limitation of *not requiring instruction data* is not found in the claims. To the contrary, the claims explicitly recite that the data carrier actions predetermine

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the actions of the data carrier reader, which implies that the data carrier does contain just such instruction data.

With respect to the arguments found in items 17 and 18, these limitations are not found in the claims and therefore the arguments are moot. That is, claim 33 makes no reference to determining which program to use. With respect to claim 34, by reciting "transfer or not" the Examiner interprets that this limitation is not required by the claims. That is, no decision is required in order to meet the claim.

For all of these reasons, claims 32-34 are properly rejected under 35 USC 102(e) as anticipated by Reber.

### **103 Claim Rejections**

33. Applicant's arguments with respect to the Herz reference have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5,664,110, note abstract;

US 5,734,823, note abstract.

35. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron C Perez-Daple whose telephone number is (571) 272-3974. The examiner can normally be reached on 9am-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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